

REMARKS

Reexamination and reconsideration of claims 29 and 31-36 are respectfully requested. Applicants acknowledge and appreciate the allowance of claims 1-14 and 38-45. Additionally, claims 15-28, 30, and 37 have been cancelled previously without prejudice.

Claims 29 and 31-36 were rejected under 35 U.S.C. sec. 103(a) applying U.S. Pat. Pub. No. 2005/0074293 (the '293 publication) without a teaching reference. It is respectfully submitted that the Office Action has failed to make a *prima facie* case of obviousness regarding claims 29 and 31-36. According to Section 706.02(j) of the Manual of Patent Examining Procedure (MPEP) a *prima facie* case of obviousness requires three basic criteria:

- (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;
- (2) there must be a reasonable expectation of success; and
- (3) the prior art reference (or reference when combined) must teach or suggest all the claim limitations.

First, the Office Action admits that the '293 publication does not teach each and every feature of independent claim 29. Specifically, the Office Action states that the '293 publication fails to teach "...the surface being a paved surface; routing at least one fiber optic cable within the duct; the duct comprising an inner tube and a jacket, the jacket formed of a compressible, heat-resistant material; and the duct being of non-round

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cross section." See p. 3 of the Office Action dated December 1, 2005. Moreover, the section 103(a) rejection does apply a teaching reference to teach the missing features. Consequently, a *prima facie* case of obviousness is lacking by the Office Action's own admission. Still further, the Office Action has not cited any objective evidence whatsoever from the '293 publication that suggests using the method and apparatus of the '293 publication on anything other than turf. For this reason alone, the withdrawal of the section 103(a) rejection of claims 29 and 31-36 is warranted and respectfully requested.

Second, there is absolutely no reasonable expectation of success for using the method and apparatus of the '293 publication on a paved surface. The skilled artisan would have understood that paved surfaces are much harder than turf and the method and apparatus of the '293 publication could not adequately slit pavement as suggested by the Office Action. Specifically, paragraph [0033] of the '293 publication states the following:

In the second instance, unlike blade type systems that gouge a slit into the turf, and trencher systems that completely remove the soil to form a trench, the underground cable laying apparatus of the present invention merely opens a slit in the turf, which is quickly reclosed once the cable has been placed therein. The angular placement of the turf slicing wheels ensures a narrow slit is initiated in the turf, is slightly widened to allow placement of the cable therein, and then is immediately reclosed by providing angular downward and inward force on the sides of the slit opened by the turf slicing wheels. As a result, it is nearly impossible to observe where a slit was opened in the turf once the cable has been laid therein. This is especially true when the turf is moist, or has been recently watered.

The skilled artisan would have understood that this process could not be accomplished with a paved surface since the paved surface is much harder than turf. Furthermore, a

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paved surface could not be opened and then immediately reclosed as taught by the method and apparatus of the '293 publication because it is a relatively hard and rigid material compared with turf. As an example of the difference between paved surfaces and turf, one merely has to think about the difference of walking on turf with shoes having cleats (such as golf shoes) and walking on concrete with the same pair of shoes having cleats.

Additionally, attached with this reply are two pages showing representative equipment used for cutting paved surfaces. As discussed in the two pages, relatively powerful engines are used for powering the cutting blade to cut paved surfaces. On the other hand, the apparatus of the '293 publication does not use a powerful engine to power turf slicing wheels 14,16. Instead, the turf slicing wheels 14,16 of the '293 publication only turn (i.e. roll) when the apparatus is moved across the turf. Thus, the skilled artisan would have understood that the method and apparatus of the '293 publication is inoperable with paved surfaces. For this reason alone, the withdrawal of the section 103(a) rejection of claims 29 and 31-36 is warranted and respectfully requested.

Additionally, there is absolutely no cited objective evidence whatsoever cited by the Office Action suggesting the use of the method and apparatus of the '293 publication on a paved surface. Consequently, the withdrawal of the section 103(a) rejection of claims 29 and 31-36 is warranted and respectfully requested.

As an independent basis, the '293 reference does not teach, disclose, or otherwise suggest a ratio between the predetermined width of the channel and the major dimension of the jacket being about 0.95 or less so that the jacket of the duct is compressed when the duct is placed within the

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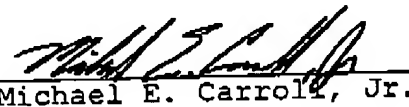
channel as recited in claim 29. For at least these reasons, the withdrawal of the sec. 103(a) rejection of claims 29 and 31-36 is warranted and respectfully requested.

No fees are believed due in connection with this Reply. If any fees are due in connection with this Reply, please charge any fees, or credit any overpayment, to Deposit Account Number 19-2167.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,


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